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JOHN F. DAVIS, CLERK

IN THE

Supreme Court of the United States

OCTOBER TERM, 1961

No. 840

ONSRUD MACHINE WORKS, INC.,
Petitioner,

vs.

EKSTROM-CARLSON & CO.,
Respondent.

On Petition For Writ Of Certiorari To The United States Court Of Appeals For The Seventh Circuit

BRIEF FOR RESPONDENT IN OPPOSITION

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INDEX

Page

Opinions Below 1

Jurisdiction 2

Questions Presented 2

Statute Involved 2

Statement Of The Case 3

ARGUMENT

Point I — Although Petitioner Raises the Question Of The Proper Standard Of Invention, It Does Not Quarrel With The Explicit Standard Applied By The District Court And Approved By The Court Of Appeals 6

Point II — Petitioner Suggests The Anomaly That Prior Art May Be Nonanalogous And Still Anticipate 7

Point III — Petitioner's Question Of Nonanalogous Art And Use Is Not A Controlling Issue In This Case 8

Point IV — Petitioner's Contention That The Claims In Issue "Deprive The Public Of The Free Use Of An Old Combination" Lacks A Factual Basis. The Court Below Found The Claims To Cover A New Machine 9

Point V — The Trial Record Itself Demonstrates That Potential Infringement Of The Patent Is Not Confined To The Seventh Circuit 10

Conclusion 11

Appendix 1a

Table of Authorities.

PAGE

Cases.

A. J. Deer Co. v. U. S. Slicing Machine Co., 21 F. 2d 812 (7th Cir. 1927) 7

Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp., 340 U.S. 147 (1950) 7

Lovell Mfg. Co. v. Cary, 147 U.S. 623 (1893) 7

Potts v. Creager, 155 U.S. 597 (1895) 7

Other Authorities.

U. S. C., Title 35, Sections 102(a), 103 2

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BRIEF FOR RESPONDENT IN OPPOSITION.

This case comes before this Court on a petition by Onsrud Machine Works, Inc., defendant below, for a writ of certiorari to review the judgment of the United States Court of Appeals for the Seventh Circuit.

OPINIONS BELOW.

The findings of facts and conclusions of law entered by the District Court holding claims 16, 17, 18, and 20 of Mann United States patent No. 2,723,598 valid and infringed (Defendant-Appellant's Appendix 303-319) are reported in 197 F. Supp. 451.

The opinion of the Court of Appeals for the Seventh Circuit and the dissenting opinion are reported at 298 F. 2d 765.

JURISDICTION.

The jurisdictional requisites are adequately set forth in the Petition.

QUESTIONS PRESENTED.

The questions presented by the Petition are questions of fact faintly disguised as questions of law. The questions presented are:

1. Did the courts below correctly find that the subject matter as a whole of claims 16, 17, 18, and 20 of Mann United States patent No. 2,723,598 was not obvious to a person having ordinary skill in the art to which the said subject matter pertains?

2. Did the courts below correctly find that the subject matter as a whole of claims 16, 17, 18, and 20 of Mann United States patent No. 2,723,598 comprises a machine for which "there was no comparable machine in existence" and not matched by any "of defendant's many pieces of prior art"?

3. Did the courts below correctly find that the "molding machines" of the prior art "were neither intended nor capable of being used with a template" and that "although widely publicized and known, . . . never inspired a development in the router art"?

STATUTE INVOLVED.

The pertinent provisions of Sections 102 (a) and 103 of the Patent Act of 1952 (U.S.C. Title 35, §§ 102 (a), 103) are quoted in petitioner's brief at page 3.

STATEMENT OF THE CASE

Petitioner's "Statement of the Case" correctly identifies the parties and the subject matter of the suit. Beyond that, however, petitioner's Statement is inaccurate. It is so because it intermingles editorial comment with fact and even assumes facts contrary to the record and findings below. We believe that the facts are stated more accurately in the findings of fact of the District Court. The appropriate ones of these findings are set out below (see Defendant-Appellant's Appendix below, pages 304-307; Petitioner's Appendix pages 5a-7a, 8a, 9a):

5. For over sixteen years before Mann made the machine of the patent in suit, the aircraft industry and others sought to obtain power actuated routers. Although other types of routers were developed for power actuation, power actuation of the double-arm router remained an unrealized goal. The need in the aircraft industry became urgent in the middle 1940's. The giants of the aircraft industry repeatedly called upon their suppliers to furnish a machine and even devoted their own engineering talent to the project. Yet, prior to Mann, all of these efforts were unsuccessful.

6. When Mann was presented with the problem in early 1951, he conceived the idea of applying power individually to each of the arms of the router by separate power actuators controlled by a single handle, the actuators serving both to hold the follower against the template and to feed the tool through the work. He was the first to recognize that the two actuators would produce a resultant force at the end which would simulate the force that had been applied manually and that the resultant force would

accurately hold the follower against the template while advancing the tool.

7. Almost immediately, North American Aviation paid tribute to Mann's conception by awarding plaintiff a purchase order for a double-arm router powered according to Mann's idea. Working continuously from early 1951, plaintiff had built and successfully tested the router by late summer of that year.

9. At the time plaintiff produced its first power actuated double-arm router, there was no comparable machine in existence nor was there any machine even approaching plaintiff's. Plaintiff sold its hydraulic machines for approximately $35,000.00 and its electric machines for $45,000.00, that being about one-eighth of the price of machines concurrently designed to do the same job. Its total business in these machines approaches three-quarters of a million dollars.

10. Not until after plaintiff had built its machine did anyone else successfully construct a power operated double-arm router. All attempts made prior to or concurrently with Mann's endeavor failed. Indeed, Lockheed Aircraft Corporation devoted an entire development project to the design and construction of such a router and, after a year's effort, abandoned the project without success.

11. Not one of defendant's many pieces of prior art matches plaintiff's router. In fact, only one (Smith, No. 2,693,737) even discloses a power operated double-arm router, and it has not been established that that antedates Mann's invention.

12. The molding machines, or so-called "Sandslingers", relied on by defendant as prior art, are ineffective to suggest the application of power to a double-arm router.

They were simply high speed device for throwing wads of molding sand into selected places in a molding flask. They were neither intended nor capable of being used with a template. The care with which the sand is rammed into flasks by such machines is an entirely different matter than the precision measured in thousandths of an inch required for a machine tool. Although widely publicized and known, the Sandslingers never inspired a development in the router art. They were not, and could not be, used for Mann's purpose.

17. Defendant's accused machine was contrived to do the same work as plaintiff's double-arm router. It has all of the same elements which serve precisely the same purpose and which are controlled in substantially the same manner. Defendant's router competes directly with plaintiff's and is the only other power actuated double-arm router in existence.

In addition, we take issue with petitioner's Statement that only petitioner and respondent manufacture double-arm routers. The record of the trial in this cause clearly demonstrates that Lockheed Aircraft Corporation, which is located in the Ninth Circuit, manufactures double-arm routers (see Appendix page 1a). Indeed, this company endeavored to develop its own power operated version of such a router (Plaintiff-Appellee's Appendix below, pages 130-148). Moreover, the affidavit appended to petitioner's brief (page 1a) does not preclude the possibility of a foreign manufacturer's importing a router, either manual or powered, into any of the various judicial circuits.

ARGUMENT

POINT I ALTHOUGH PETITIONER RAISES THE QUESTION OF THE PROPER STANDARD OF INVENTION, IT DOES NOT QUARREL WITH THE EXPLICIT STANDARD APPLIED BY THE DISTRICT COURT AND APPROVED BY THE COURT OF APPEALS.

Petitioner's first question presented for review and the second point of its argument asks this Court to spell out the standard of invention required by Section 103 of the Patent Act. On its face, this would seem to presuppose that petitioner felt the courts below had adopted too low a standard. Yet, petitioner has not even alluded to the test of invention expressed by the District Court.

The standard applied below was not left to conjecture. The District Court stated the predicates of invention in its first Conclusion of Law (Defendant-Appellant's Appendix below, page 307):

> To be patentable, a device must not only be new and useful, it must also be the product of true "invention". It must be beyond the reasonable expectations of persons of ordinary skill in the art, the routineers of the field. The expectable improvements, the normal evolutionary improvements of devices under the rub of competition do not qualify as patentable inventions.

The Court of Appeals expressly approved this as being the "correct legal criteria" of invention (Petitioner's Appendix, page 11a).

Petitioner has failed to state where it is at variance with the District Court's view of invention. The standard applied below is in strict keeping with the standard of

invention pronounced by this Court (cf. *Great Atlantic & Pacific Tea Co.* v. *Supermarket Equipment Corp.*, 340 U.S. 147 (1950).

The question thus presented is not a new question. Nor is it a question on which there has been a conflict of decision. The issue presented is merely an issue of fact.

Manifestly, Petitioner's first question does not raise an important question of Federal law requiring decision by this Court. In proper perspective it raises only a review of the evidence in this case.

POINT II — PETITIONER SUGGESTS THE ANOMALY THAT PRIOR ART MAY BE NONANALOGOUS AND STILL ANTICIPATE.

In its second and third questions presented for review (the third and sixth points of its argument), petitioner candidly admits that the molding machine, known as the "Sandslinger", is nonanalogous art so far as the art of the patent in suit is concerned. In the same breath, however, petitioner ask this Court to resolve that the "Sandslinger", even though nonanalogous, anticipates the patented router. Petitioner is merely playing with semantics.

The term "nonanalogous art" is merely a name used by the courts for convenience of description. In 1927 the court below used the term as descriptive of prior art in which the "elements and purposes" are not sufficiently related and similar to those of another art to "make an appeal to the mind of a person having mechanical skill of the purposes of the other art." *A. J. Deer Co.* v. *U. S. Slicing Machine Co.*, 21 F. 2d 812 (7th Cir. 1927). That is the manner of use in this case. This usage was established long ago by this Court. *Lovell Mfg. Co.* v. *Cary*, 147 U.S. 623 (1893); *Potts* v. *Creager*, 155 U.S. 597 (1895).

There is no conflict of decision on this usage of the term "nonanalogous" art, and none is suggested by Petitioner. We submit that the applicable law is too well settled to require review.

POINT III — PETITIONER'S QUESTION OF NONANALOGOUS ART AND USE IS NOT A CONTROLLING ISSUE IN THIS CASE.

In its petition, petitioner repeatedly states that the "Sandslinger" differs from the patented router only in its *use* and that only the use is nonanalogous to the use of the router (at pages 3, 6, 7, 12, and 13). These are facts assumed by petitioner. *They are not the facts of the record or the facts found below.*

The District Court found that not only were the uses different but also that the *structures* were different as well. Thus, that court found that, "Not one of defendant's many pieces of prior art matches plaintiff's router." (Defendant-Appellant's Appendix below, page 305). Equally significant is the holding of the Court of Appeals that the router and the "Sandslinger" have "no similarity of their *elements* and purposes." (Petitioner's Appendix, page 8a, emphasis added).

In the guise of a legal issue petitioner in actuality is contesting the findings of fact, such as questions two and three set out herein at page 2. These matters, we believe, are not of sufficient importance for review by this Court.

POINT IV — PETITIONER'S CONTENTION THAT THE CLAIMS IN ISSUE "DEPRIVE THE PUBLIC OF THE FREE USE OF AN OLD COMBINATION" LACKS A FACTUAL BASIS. THE COURT BELOW FOUND THE CLAIMS TO COVER A NEW MACHINE.

Petitioner's third question presented for review is merely another expression of its previous questions. Petitioner complains that claims held valid below withdraw what was already known and available for the free use of the public. This is directly contrary to the facts found below.

The District Court found that, "Not one of defendant's many pieces of prior art matches plaintiff's router" and that the "Sandslinger" molding machines "are ineffective to suggest the application of power to a double-arm router" (Defendant-Appellant's Appendix below, pages 305 and 306). The Court of Appeals, in affirming, said that the patented router was a new machine and that even parts common to the old routers "perform new and different functions" (Petitioner's Appendix, pages 9a and 10a).

In support of its contention, petitioner creates the illusion that its router was derived from the prior art (see petitioner's brief at page 7). This, however, is not a fact found below. Indeed, the Court of Appeals specifically recognizes that petitioner *imitated* respondent's router (Petitioner's Appendix, page 11a).

Again, we submit petitioner asks this Court to review findings of fact, not issues of law.

POINT V — THE TRIAL RECORD ITSELF DEMONSTRATES THAT POTENTIAL INFRINGEMENT OF THE PATENT IS NOT CONFINED TO THE SEVENTH CIRCUIT.

Supported only by the affidavit of the chairman of its board of directors, petitioner asserts that the manufacture of double-arm routers is limited to petitioner and respondent both of which are in Illinois. From this, petitioner asserts that further litigation of the patent is improbable and advances this as a reason for review by this Court.

The facts adduced at trial by petitioner's own witness, however, contradict this position. The trial record clearly establishes that Lockheed Aircraft Corporation in California has manufactured its own double-arm routers (See Respondent's Appendix page 1a) and that this same company has attempted to build a power actuated double-arm router (Plaintiff-Appellee's Appendix below, pages 131-148).

Moreover, petitioner's affidavit does not preclude foreign manufacturers' importing into the United States. In such an event, infringement could take place in any of the judicial circuits.

CONCLUSION.

For the reasons set forth above, we submit that the petition for a writ of certiorari should be denied.

Respectfully submitted,

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APPENDIX.

1 • • • Transcript of proceedings had in the trial of the above entitled case before Hon. J. Samuel Perry, one of the Judges of said Court, in his courtroom in the United States Court House, Chicago, Illinois, on January 12, 13, 14, 15 and 16, 1960.

• • •

2-755 • • •

756 The following is the deposition of Reed B. Scott:

"REED B. SCOTT, called as a witness on behalf of the defendant, under the Federal Rules of Civil Procedure, having been first duly sworn, testified as follows:

The Notary: Will you please state your name.
The Witness: Reed B. Scott.

Direct Examination by Mr. Rummler.

• • •

757-792 • • •

793 "• • • Q. Mr. Scott, I hand you another document and ask you if you can identify it.

A. This is a page from the Manufacturing Standards Manual, Division 9, which is a document that has
794 "been published by the chief manufacturing engineer's organization for at least 15 years. Division 9 was set up to give basic dimensions of production machines and to identify them for the use of planners and tool designers.

Q. Is that within the Lockheed organization?

A. Within the Lockheed organization.

Q. And is that page that you have an original?

A. This page is an original page from one of the manuals, and it gives the basic dimensions of a broken arm or articulated arm router, and identifies it as an Onsrud master router, which is the phrase I mentioned to you. The word 'master' being Lockheed terminology, appears in one of our official documents.

Q. What is on the reverse side of that page, Mr. Scott?

A. An articulated arm router of Lockheed's own manufacture. At this period, the date of this page, which was June 6, 1946, we were using both Onsrud machines and some earlier machines that we had constructed ourselves. This router we also called a master router.

• • •

795-1099 • • •